

Applicant: Heikki Vatanen et al.
Application No.: 10/598,181
Response to Office action mailed Feb. 16, 2010
Response filed March 9, 2010

A More Detailed Exposé of the Arguments Made During the Interview

The examiner summarizes his argument as:

Taking the teaching of the references as a whole: there exists the desirability of monitoring and controlling layer thickness profile, the desirability to determine and control thicknesses of each layer of a multilayer stack, and the teaching to a thickness sensor capable of collecting thickness data from points along and across the entirety of a flow plane; as such, a combination of such references would *support measuring the cross machine direction profile of any or all layers as well as the desire to control such thicknesses*. (Office Action mail date Feb. 16, 2010, p. 16, line 21 to p. 17, line 3.)

The test:

MPEP 2143 A. [emphasis supplied] *Combining Prior Art Elements According to Known Methods To Yield Predictable Results*

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the *only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference*;
- (2) a finding that *one of ordinary skill in the art could have combined the elements as claimed by known methods*, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The error in the examiner's reasoning is that it could be entirely correct and yet does not make out a *prima facie* case of obviousness, because the references do not show or

Applicant: Heikki Vatanen et al.
Application No.: 10/598,181
Response to Office action mailed Feb. 16, 2010
Response filed March 9, 2010

suggest any means for bringing about the applicant's claimed "*regulating thereby each layer cross-profile and thickness*" (claim 11), or "*achieve a selected cross machine direction thickness profile for said first layer ...and the second layer of coating material*" (claim 19). In particular under MPEP 2143A(2) the examiner's rationale lacks an explanation of how the claim elements could be combined by known methods, wherein the prior art elements are such that they cannot be combined. The co-pending U.S. App. No. 10/571,224, has been allowed with claims to two structures by which the combination can be made. There being no comparable structures in the prior art, a person of ordinary skill in the art is missing a known method of combining elements so as to render the claims obvious.

Applicant submits that the claims, are in condition for allowance. Favorable action thereon is respectfully solicited.

Respectfully submitted,



Patrick J. G. Stiennon, Reg. No. 34934

Attorney for Applicant

Stiennon & Stiennon

P.O. Box 1667

Madison, Wisconsin 53701-1667

(608) 250-4870

amdt3.res

March 9, 2010 (10:41am)